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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,062	01/29/1999	THOMAS GRAF	2565/45	6866
26646	7590	08/02/2004		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			EXAMINER CHOI, STEPHEN	
			ART UNIT 3724	PAPER NUMBER
DATE MAILED: 08/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/240,062

Applicant(s)

GRAF ET AL.

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,19 and 20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,5,19 and 20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 January 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the claimed method of manufacturing a filter element for a dialyzer set forth in claims 19-20.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matino et al. (US 3,304,821) in view of Anderson, Jr. et al. (US 3,986,417).

Matino discloses the invention substantially as claimed including steps of:

- a) transporting a fiber bundle strand using at least one feed element (5,6);
- b) pre-cutting the fiber bundle strand into unbound partial bundles, the

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unbound partial bundles having a length when pre-cut equal to the fiber bundle length (1,2);

c) releasing the unbound partial bundles from the at least one feed element (the unbound partial bundles are released from the feed element as the fiber bundle strand is cut);

d) gripping the unbound partial bundles using at least one gripping element (8-11);

e) releasing the unbound partial bundles from the at least one gripping element (col. 1, lines 17-18);

f) repeating steps for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained.

Matino fails to disclose a step of placing the unbound partial bundles in a first collection trough of a collection device. Anderson teaches the use of trough for collecting cut filaments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the trough as taught by Anderson on the device of Matino in order to gather the unbound partial bundles released from the gripping element. Regarding claim 19, the fiber bundles manufactured by the modified method of Matino can be used for manufacturing a filter element for a dialyzer.

5. Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matino et al. (US 3,304,821) in view of JP 55142580 (hereinafter '580).

Matino discloses the invention substantially as claimed except for steps of placing the unbound partial bundles in a first collection trough of a collection device and

rotating the collection device after the first trough is filled and placing the unbound partial bundles in a further trough of the collection device. '580 discloses a rotating collection device having troughs (7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the collection device as taught by '580 on the device of Matino in order to selectively collect a required volume of fiber bundles. Regarding claim 20, the fiber bundles manufactured by the modified method of Matino can be used for manufacturing a filter element for a dialyzer.

### ***Response to Arguments***

6. Applicant's arguments filed 29 April 2004 regarding the rejection under 35 USC 112, 1<sup>st</sup> paragraph have been fully considered but they are not persuasive.

Applicants contend that the specification fully supports the claimed method of manufacturing a filter element for a dialyzer.

The examiner respectfully disagrees. The specification does state that the fiber bundles are used for the manufacturing of dialyzers or in the dialysis machine; however, there is no support in the specification for the claimed method of manufacturing of a **filter element**.

7. Applicant's arguments with respect to claims 1, 5, and 19-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday-Friday 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sc  
30 July 2004

  
**STEPHEN CHOI**  
**PRIMARY EXAMINER**